

REMARKS

In view of the comments which follow, and pursuant to 37 C.F.R. § 1.111, reconsideration of the Official Action of January 20, 2004 is respectfully requested by Applicant.

Summary

Claims 1 – 11, 14, 16, 17, 20 – 24, 27 – 32, 35 – 38, 41, 49 – 52, 54 – 57, 60, 62, 63 and 67 stand rejected. Claims 1, 20 and 54 have been amended. No new matter has been introduced as a result of these amendments. Claim 9 has been cancelled. Amended, original and previously presented claims provided in the Listing of Claims section are pending following entry of the present amendments, and remarks.

Rejection under 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-5, 7-9, 14, 16-17, 20-21, 23-26, 28-29, 30-32, 41, 46, 49 – 52, 60 and 62-63 under 35 U.S.C. 103(a), as being unpatentable over Ryan (U.S. Patent 6,064,993) and further in view of Harvey et al. (U.S. Patent 6,026,385).

In this rejection, the Examiner has combined Ryan's patent, which relates to a remote control of the printer, with Harvey's patent, which relates to a printing of an image file as indicia. Claim 1 has been amended to clarify the invention and remove any ambiguities. As such, claim 1 now recites providing printing instructions for printing said electronic certificate, transmitting by said provider said printing instructions with said electronic certificate data at least partially contained within an image file to said consumer's printer on said second communication connection, and controlling a printing of said electronic certificate using said printing instructions from said provider to print said electronic certificate on said consumer's printer. As amended, claim 1 is now distinguishable from the cited references.

Thus, the printing is in effect controlled by the provider's via the printing instructions transmitted to the printer. This is in contrast to the Ryan reference that teaches controlling the printer for an electronic certificate by the user's computer. Ryan states "Control unit 36 which contains a microprocessor, memory means and non-volatile storage controls all machine operations, including communication with the Data Center, user interface and printing functions" (column 4, lines 32-35). Thus the printing instructions come from the control unit 36 and not from the provider as presently claimed. The Examiner points out that in Ryan at step 135, Fig. 2, the printer acknowledges receipt of the printing data from the provider's directly. However, there is no disclosure that the provider controls the printing by sending both the certificate and the printing instructions to the printer. In addition, Ryan states that the printer module 30 acknowledges the response instead of the printer 34. Further, Ryan discloses that "at step 145, the printer module 30 formats the indicia for printing" (column 5, lines 31 - 32), and that "At step 150, the printer module 30 prints the indicia" (column 5, lines 35 - 36). Hence in Ryan the printer module 30 controls the printer, not the provider.

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In addition, claim 1 recites a step of establishing a second communication connection from the provider to the consumer printer. In contrast, Ryan is silent about establishing such second communication connection from the provider to the consumer printer. Further, the Examiner states that while communicating on Internet via browsers like Netscape or Internet Explorer the printers can have two or more communication connections directly with the provider. However, Applicant respectfully disagrees in that these Internet connections between providers and printers are not established as secondary connections to original connections that facilitated the submission of corresponding transaction requests from the consumer printer to the provider.

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In regard to the Harvey reference, the Examiner states that Harvey discloses the printing of data such as electronic certificate/document contains an image. However, Applicant submits that Harvey does not disclose controlling the printing of data by the provider on the consumer's printer using printing

instructions from the provider. Further, Harvey also fails to teach establishing a second communication connection to the provider to the consumer's printer.

Therefore, Applicant submits for at least the above stated distinguishing features, no indication or suggestion exists that these two separate references, even when combined, would motivate one of ordinary skill in the art to arrive at the present invention.

Hence claim 1 is allowable as well as claims 2 – 11, 14, 16, 17, and 49 – 52, which are either directly or indirectly dependent on allowable claim 1. Further, independent claims 20, 23, 30, and 54 include the same distinguishing feature of controlling a printing at the consumer's printer by the provider using the provider's printing instructions from the Ryan and Harvey references, and thus Applicant submit that these claims are also allowable as well as their respective dependent claims 21, 22, 24, 27, 28, 31, 32, 35 – 38, 41 and 55 – 67.

Therefore, Applicant therefore respectfully requests that the rejection of Claim 1-5, 7-9, 14, 16-17, 20-21, 23-26, 28-29, 30-32, 41, 46, 49 – 52, 60 and 62-63 under 35 U.S.C. 103(a) be withdrawn.

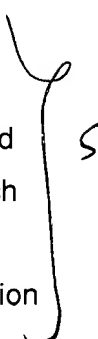
The Examiner has further rejected claim 35 under 35 U.S.C. 103(a), as being unpatentable over Ryan and in view of Harvey and further in view of the Admitted Prior Art by the Applicant (APAA). In regard to the Examiner suggestion that the Applicant has admitted printing on CD ROM as a prior art, Applicant respectfully points out to the Examiner that claim 35 is dependent on claim 30, which discloses printing with printing instructions received from a provider. In support, Applicant's disclosure states that "The music vendor (provider) may directly control the end-user's printer for receiving and printing the requested indicia on the CD ROM, without the end-user's intervention", (See disclosure on page 9, lines 24 – 27). This control of the printing by the provider was not admitted by the Applicant as Prior Art.

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Thus, based on the prior discussions of the Ryan and Harvey references and of the APAA, Applicant submits that no indication or suggestion exists that the Ryan and Harvey references and the Examiner suggested APAA, even

when combined, would motivate one of ordinary skill in the art to arrive at the present invention. As such, claim 35 is allowable, and Applicant respectfully requests that the rejections of claim 35 under 35 U.S.C. § 103(a) be withdrawn.

The Examiner has next rejected claims 6, 22 and 27 under 35 U.S.C. 103(a), as being unpatentable over Ryan and in view of Harvey and further in view of Hayward et al. (US 2003/0023703). In regard to the Examiner suggestion that the Hayward reference discloses that the provider confirms that the printer has sufficient supplies and that it is connected to the network, Applicant respectfully points out that claims 6, 22, and 27 are dependent on claims 1, 20 and 23, which discloses printing with printing instructions received from a provider. In contrast, Applicant submits that Hayward also fails to teach or suggest that the printing is controlled by the provider using transmitted printing instructions. As such, Applicant submits that no indication or suggestion exists that the Ryan, Harvey and Hayward references, even when combined, would motivate one of ordinary skill in the art to arrive at the present invention. As such, claims 6, 22 and 27 are allowable, and Applicant respectfully requests that the rejections of claims 6, 22 and 27 under 35 U.S.C. § 103(a) be withdrawn.


A handwritten bracket on the right side of the text, spanning from the sentence 'Applicant respectfully points out that claims 6, 22, and 27 are dependent on claims 1, 20 and 23...' down to 'no indication or suggestion exists that the Ryan, Harvey and Hayward references, even when combined, would motivate one of ordinary skill in the art to arrive at the present invention.' To the right of the bracket is a handwritten symbol resembling a stylized 'S' or a checkmark.

The Examiner has further rejected claims 10, 38 and 57 under 35 U.S.C. 103(a), as being unpatentable over Ryan and further in view of Official Notice. Claims 10, 38 and 57 relate to the printing of bar codes or original financial certificates. Applicant respectfully points out that claims 10, 38 and 57 are respectively dependent, directly or indirectly, on allowable claims 1, 30 and 54, which discloses printing with printing instructions received from a provider. As such, claims 10, 38 and 57 are allowable, and Applicant respectfully requests that the rejections of claims 10, 38 and 57 under 35 U.S.C. § 103(a) be withdrawn.

A handwritten bracket on the right side of the text, spanning from the sentence 'Applicant respectfully points out that claims 10, 38 and 57 are respectively dependent, directly or indirectly, on allowable claims 1, 30 and 54...' down to 'As such, claims 10, 38 and 57 are allowable, and Applicant respectfully requests that the rejections of claims 10, 38 and 57 under 35 U.S.C. § 103(a) be withdrawn.' To the right of the bracket is a handwritten symbol resembling a stylized 'S' or a checkmark.

The Examiner has next rejected claim 11 under 35 U.S.C. 103(a), as being unpatentable over Ryan and Harvey, and in further view of Grapes (U.S. Patent 6,446,130). Applicant respectfully points out that claim 11 is dependent on allowable claim 1 which discloses printing with printing instructions received

from a provider. As such, claim 11 is allowable, and Applicant respectfully requests that the rejections of claim 11 under 35 U.S.C. § 103(a) be withdrawn.

The Examiner has next rejected claims 36 and 37 as being unpatentable over Ryan and Harvey, and in further view of Templeton (U.S. Patent 6,547,132) and further Official notice. Applicant respectfully submits that claims 36 and 37 are dependent, directly or indirectly on allowable claim 30 which discloses means for printing said printing data according to the printing instructions under the remote provider's direct control without involvement of the consumer. As such, claims 36 and 37 are allowable, and Applicant respectfully requests that the rejections of claims 36 and 37 under 35 U.S.C. § 103(a) be withdrawn. 

The Examiner has further rejected claim 67 under 35 USC 103(a) as being unpatentable over Ryan/Harvey and in view of Official Notice and in further view of Hayward. Applicant respectfully submits that claim 67 is dependent on allowable claim 54. As such, claim 67 is allowable, and Applicant respectfully requests that the rejection of claim 67 under 35 U.S.C. § 103(a) be withdrawn.

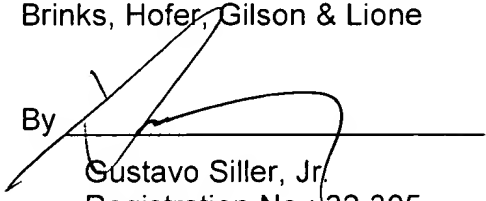
Conclusion

Applicant submits that this application is now in condition for allowance, and favorable reconsideration of this application in view of the above amendments and remarks is respectfully requested. Applicant believes a three month extension is due with respect to the present amendment, and a corresponding check is enclosed. If, there are additional fees due, Applicant requests that this paper constitutes any necessary petition and authorizes the Commissioner to charge any underpayment, or credit any overpayment, to Deposit Account No. 23-1925

If the examiner finds that there are any outstanding issues which may be resolved by a telephone interview, the Examiner is invited to contact the undersigned at the below listed number

Respectfully submitted,
Brinks, Hofer, Gilson & Lione

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